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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,197	01/23/2002	Joelle Thonnard	BM45399	2955

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EXAMINER

BASKAR, PADMAVATHI

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 09/20/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/048,197

Applicant(s)

THONNARD, JOELLE

Examiner

Padmavathi v Baskar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27, 29, 32, 34, 35, 38, 43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27, 29, 32, 34, 35, 38, 43 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Applicant's election of Group I claims 27, 29, 32, 34, 35, 38, 43-44 (polypeptide) in Paper No. 7 (7/7/02) without traverse is acknowledged. Claims 28, 30, 31, 33, 36, 37, 39, 40-42 and 45-49 have been canceled. Claims 27, 29, 32, 34, 35, 38, 43-44 are pending in the application.

#### ***Priority***

2. This application is a 371 OF PCT/EP 00/07365, 7/31/2000 (WO 00109337), which claims priority under 35, U.S.C. 119 (a)- (d) to U.K 9918034.1; 7/30/1999 and U.K 9918036.6; 7/30/1999 is acknowledged. Examiner has reviewed all the priority documents and found that the SEQ.ID.NO: 2 containing 111 amino acids in the present application was not disclosed in the priority documents, U.K 9918034.1 and U.K 9918036.6. It is noted that the SEQ.ID.NO: 2 of the present application are not the same as the SEQ.ID.NO: 2 of the U.K 9918034.1; 7/30/1999 and U.K 9918036.6; 7/30/1999. Therefore, this application gets priority as of filing date of PCT/EP 00/07365, 7/31/2000 for claims 27, 29, 32, 34, 35, 38, 43-44.

#### ***Information Disclosure Statement***

3. The Information Disclosure Statement has not been filed in this application.

#### ***Specification - Informalities***

4. Applicant should follow the direction or order or arrangement in framing the specification as provided in 37 CFR 1.77(b) since this is a utility application filed in USA. The specification should include all the sections in order. For example: Claims should begin with "I claim" or "We claim" or "What is claimed is".

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It is noted that Abstract of the Disclosure is missing. If applicant desires to include the abstract from PCT/EP 00/07365, the Office would consider and a copy of the abstract will be inserted in to the specification. There are no line numbers in the specification pages.

***Claim Rejections - 35 USC 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 43-44 and the dependent claim<sup>27</sup> (as a vaccine composition only) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Instant claims are evaluated for enablement based on the Wands analysis. Many of the factors regarding undue experimentation have been summarized in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed.Circ.1988) as follows:

(1) the nature of the invention, (2) the state of the prior art, (3) the predictability or lack thereof in the art, (4) the amount of direction or guidance present, (5) the presence or absence of working examples, (6) the quantity of experimentation necessary, (7) the relative skill of those in the art, and (8) the breadth of the claims.

The definition of "vaccine" is broad, it is not so broad to cover any use of a substance on or in the body of a subject, only those uses intended to prevent, treat, or cure a disease within the animal to which the substance was administered.

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Enablement of a "vaccine composition" is considered to rest on a teaching of *in vivo* administration for purposes consistent with the intended use disclosed in the specification. The disclosed intended use for the claimed vaccine is for the treatment of otitis media and respiratory disease caused by *Moraxella catarrhalis* infections. Thus, the nature of the invention is a therapeutic composition used in the treatment or prevention. In the instant application, the animal to which the claimed composition is administered is merely being used as a bioreactor to make the antibodies (example 5) that will ultimately be used *in vitro*. In addition, the instant specification does not teach how to use the composition, without undue experimentation, for the prevention, treatment, or cure of a disease in the animal to which the substance is administered.

The specification discloses the claimed composition as an immunogen (pages ~~57-60~~ 57-60) and formulating the compositions in Freund's adjuvant. In the instant application, the animal to which the claimed composition is administered is merely being used as a bioreactor to make the antibodies (example 5), there is insufficient guidance which would enable one skilled in the art to use the claimed compositions for their intended purpose, viz., for the generation of a protective immune response against otitis media and respiratory disease caused by *Moraxella catarrhalis* infections. At the time the invention was made, vaccines comprising the claimed polypeptide were not routinely used for the treatment of otitis media and respiratory diseases. The specification lacks guidance by way of general methods or working examples which teach an "effective amount" of the vaccine which would be used for this purpose. Lack of working examples is given added weight in cases involving an unpredictable and undeveloped art, such as immunotherapy of otitis media and respiratory diseases. It is unpredictable whether the claimed composition, which is disclosed as being only immunogenic, would have the added property of generating the protective immune response sufficient to inhibit the otitis media and respiratory diseases because the prior art discloses that vaccine development is at the antigen

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identification stage and testing of these protective antigens is by testing them in animal models or clinical testing of these antigens (see review article by McMichael , 2000, Microbes and Infection 2; 561-568 ) The specification has not disclosed a link or nexus between the generation protective antibodies and its use in the above disorders. Further, it is not routine in the art of immunotherapy to use the claimed compositions for this purpose. Accordingly, there is no objective basis upon which the skilled artisan would reasonably be able to determine or predict an amount of the claimed composition/vaccine effective for its intended use. Therefore, undue experimentation would be required to make and use the invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 27, 29, 32, 34, 35, 38, 43-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 is rejected as being vague and not clear in reciting " T-cell immune response to a polypeptide having the sequence of SEQ.ID.NO: 2." It is not clear what T-cell immune response applicant intend to mean. Does applicant intend to mean T-cell mediated immune response, which induces TH1 type, or TH-2 type (i.e., cytokine dependent) immune response or something else? It is not clear whether T-cell mediated response is to the polypeptide SEQ.ID.NO: 2 or something less than a polypeptide SEQ.ID.NO: 2 since the claim recites "a polypeptide".

Claim 38 is objected as it depends from a canceled "claim 21"

Claim 44 is rejected for the recitation of " one other M.catarrhalis antigen". It is difficult to understand the metes and bounds of one other M.catarrhalis antigen as written.

### Claim Rejections - 35 USC 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 27, 29, 32, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Helminen et al 1994 (J.Infec.Dis, 170; 867-872).

Claims are directed to an isolated polypeptide comprising (a) an amino acid sequence matching SEQ.ID.NO: 2 (b) an immunogenic polypeptide comprising a fragment of SEQ.ID.NO: 2 where in the polypeptide, when administered with a carrier induces an antibody response or t-cell response.

Helminen et al 1994 disclose an isolated polypeptide, outer membrane protein i.e., OMP from whole cell lysate of *M.catarrhalis*. Monoclonal antibodies were produced by administering (i.e., immunizing) whole cell lysate antigens to mice (page 867, right column through page 868, left column, first paragraph). Applicant's use of the open-ended term "comprising" in the claim 27 fails to exclude unrecited steps or ingredients and leaves the claims open for inclusion of unspecified ingredients, even in major amounts. Therefore, the claims read on the disclosed isolated polypeptide, OMP from *M.catarrhalis*. Whole cell lysates from *M.catarrhalis* inherently comprise the amino acid sequence as set forth in the SEQ.ID.NO: 2 and fragments of

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SEQ.ID.NO: 2. See In re Horvitz, 168 F 2d 522, 78 U.S.P.Q. 79 (C.C.P.A. 1948) and Ex parte Davis et al., 80 U.S.P.Q. 448 (PTO d. App. 1948). In the absence of evidence to the contrary the disclosed prior art protein and the claimed isolated polypeptide comprising (a) an amino acid sequence matching SEQ.ID.NO: 2 are the same. Since the Office does not have the facilities for examining and comparing applicants' claimed isolated polypeptide comprising SEQ.ID.NO: 2 with the polypeptide of prior art, the burden is on applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

11. Claims 27, 29, 32 and 34 are rejected under 35 U.S.C. 102(a) as being anticipated by Lagace et al 2000 WO 0078968: pages 87-88 (Examiner is enclosing only pages 87-88 from the Patent WO 0078968: as the patent is length containing 456 pages).

Claims are directed to an isolated polypeptide comprising a member selected from the group consisting of an (a) an amino acid sequence matching SEQ.ID.NO: 2 (b) an immunogenic polypeptide comprising a fragment sequence of at least 15 amino acids that matches an aligned contiguous segment of SEQ.ID.NO: 2, where in the isolated polypeptide induces an antibody or T-cell immune response.

Lagace et al disclose an isolated polypeptide (see claim 10 for SEQ.ID.NO: 38, pages 87-88) encoded by polynucleotide from position 75267-75599 comprising an amino acid sequence matching SEQ.ID.NO: 2 (see the attached Accession # AX 067463 for the disclosed polynucleotide from positions 75267-75599 of SEQ.ID.NO: 38 encoding SEQ.ID.NO: 2). The disclosed polypeptide is 100% identical to SEQ.ID.NO: 2. Further, the prior art discloses an isolated polypeptide comprising 15 amino acid contiguous segment of SEQ.ID.NO: 2. The prior art anticipated the claimed invention.



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The art teaches that an immunogenic fragment (i.e., antigen or epitope) is roughly 5 amino acids in size (Levinson et al Medical Microbiology & Immunology 1994, page 293) and an antigen can have one or more determinants (i.e., epitopes). Epitopes can elicit an immune response and react with an antibody. Therefore, Legace et al meet the limitations (i.e., peptide comprising at least 15 amino acids) of the claims.

### **Status of Claims**

12 No claims are allowed.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padma Baskar whose telephone number is (703) 308-8886. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4 PM EST

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Padma Baskar Ph.D.

9/13/02

  
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